

## **REMARKS**

Claims 1, 11, 24, 31, 35, 36, and 38-41 stand amended in the present Amendment. Support for the amendments to claims 1, 11, 24, 35, and 36 may be found in the application at page 13, lines 17-22 to page 14, lines 1-3, and elsewhere in the application as originally filed.

Claims 31 and 38 stand amended to correct obvious typographical errors (including a period at the end of claim 31 and correcting the spelling of the word “least” in claim 38). The dependency of claims 39-41 is corrected in accordance with the renumbering of the claims.

Applicants note that new claims 36-41 were incorrectly numbered in the Amendment filed on August 11, 2006. A claim numbered “35” was presented on page 11 of the Amendment, and a claim numbered “35” was also presented on page 12 of that Amendment. The claims listed after the first “claim 35” are now correctly numbered as claims 36-42 in the present Amendment. These claims are not indicated as “currently amended” unless the text of the claim has been amended, as Applicants believe that correction of the numbering of a claim is not an amendment of that claim.

No new matter is added by way of the amendments to the claims.

Claims 1-18 and 24-41 are pending in the application, and stand rejected.

Applicants respectfully traverse these rejections.

### **The Rejections of Claims 1-18 and 24-41 under 35 U.S.C. § 103(a)**

Claims 1-18 and 24-41 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over Smith (U.S. Patent 3,737,365, hereafter “Smith”) in view of Simmons, Jr. (U.S. Patent 5,286,545, hereafter “Simmons”). However, as discussed below, the cited references fail to make the claimed invention obvious.

In order to establish a prima facie case of obviousness, there must be 1) some suggestion or motivation in the art or in the knowledge generally available to one of ordinary skill in the art, to modify or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of

success must be found in the prior art, and not based on the applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The present application is directed to methods for inlaying designs into laminate sheets, including laminate sheets made from a variety of polymer materials, and has particular utility for use in manufacturing sports boards. The cited references are directed to methods and articles of manufacture of inlaid wood, and do not mention polymeric materials nor sports boards.

Applicants note that neither of the cited references discuss polymers, and in particular that the cited references do not disclose or suggest polyethylene, polystyrene, polypropylene, or polyvinylchloride. Applicants further note that the USPTO provides no support, in the cited references or elsewhere, for the suggestion that different types of wood inherently have different surface properties including different coefficients of friction. The USPTO further suggests, without support in the cited references, that it would have been obvious to one having ordinary skill in the art at the time of the invention to employ the wood-working methods of Smith and Simmons to polymeric materials. Applicants traverse these suggestions.

The present application teaches novel and inventive methods for inlaying a design into a laminate sheet and for bonding the inlaid laminate sheet to a core structure or core substrate. Among the many teachings of the present application, Applicants teach improved methods of securing inlay components by applying heat through a non-stick layer to a bonding material effective to hold a composite inlay design in place. Such steps are discussed, for example, in the application at pages 13-14, illustrated in Figure 19, and elsewhere in the application. Thus, in this instance, in addition to the other teachings, Applicants provide new and surprising methods including steps for holding a composite inlay design in place for subsequent manufacturing steps, thereby providing an improved solution to a problem in the art.

Thus, among other steps, the claimed invention requires steps of:  
placing an insert in the aperture of a laminate sheet to provide a composite inlay design;  
and  
securing the insert in place in the aperture of the laminate sheet by applying heat through a non-stick layer to a bonding material effective to hold said composite inlay design in place.

These, or analogous, steps are required in independent claims 1, 11, 24, 35, and 36, and in their dependent claims. Thus, such steps are required in all pending claims.

However, although the cited references discuss tape and suction to hold inlay components, neither Smith nor Simmons discusses or suggests securing inlay components by applying heat through a non-stick layer to a bonding material effective to hold a composite inlay design in place. No combination of the teachings of Smith with Simmons provides or suggests such a step. There is no suggestion in the combined references to provide such a step, nor (e.g., in view of their discussion of tape or suction) is there any motivation in those references to provide the claimed steps. Moreover, the cited references, lacking disclosure or suggestion of such steps, provide no reasonable expectation of success for such steps. Thus, Smith, Simmons, and the combination of Smith and Simmons together, all fail to provide all the elements of the claimed invention.

Lacking all the elements of the claimed invention; lacking any suggestion of the missing elements; lacking any motivation to provide the missing elements; and lacking any reasonable expectation of success for methods including the missing steps, the cited references fail to make the claimed invention obvious.

Accordingly, since the cited references do not disclose or suggest methods including steps of applying heat through a non-stick layer to a bonding material effective to hold a composite inlay design in place, provide no motivation to combine the cited references to provide the claimed invention, and do not provide any reasonable expectation of success were the references to be so combined, Applicants respectfully submit that claims 1-18 and 24-41 are not made obvious by Smith and Simmons.

Accordingly, Applicants submit that the rejections of claims 1-18 and 24-41 under 35 U.S.C. § 103(a) are overcome.

## CONCLUSION

Reconsideration and allowance of all pending claims is respectfully requested.

The Examiner is invited to contact the undersigned attorney at the telephone number indicated below should he find that there are any further issues outstanding.

Please charge fees for the requested three-month extension of time, and any additional fees, if any, including any fees for extension of time, or credit overpayment to Deposit Account No. 08-1641 referencing Attorney's Docket No. 44351-0023.

Respectfully submitted,

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